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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/621,864

07/16/2003

Ethan R. Bradford

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EXAMINER

SPOONER, LAMONT M

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/621,864	Applicant(s) BRADFORD ET AL.	
	Examiner LAMONT M. SPOONER	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-16,19-31,34,45 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-16,19-31,34,45 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/9/08, 10/24/08, 11/13/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. This office action is in response to applicant's amendment filed on 10/15/08. Claims 1, 4-16, 19-31, 34, 45, and 48 are currently pending and have been examined. Applicant's IDS have been considered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 4-16, 19-31, 34, 45 and 48 have been considered but are moot in view of the new ground(s) of rejection. The Examiner notes and appreciates applicant's attempt to clarify the previous 35 USC 112 issues, however, the Examiner notes new ambiguous and indefinite issues with respect to the amended claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 4-16, 19-31, 34, 45 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More specifically, in claim 1, line 7, "retrieving any words from said LDB that match user's input" is not found anywhere in applicant's original disclosure. See for example, p.2 lines 30-38 of applicant's specification, which detail, "complete words are dynamically displayed to the user that begin with the letters represented by the key presses."

Claims 9, 15, 16, 24 and 30 have the same issues, and are thus rejected accordingly.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 4-16, 19-31, 34, 45, and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically:

In claim 1, line 9, "said word" has ambiguity issues, with at least, "each word" as discussed in line 5.

In claim 1, line 9, "if said list does not include a word" is ambiguous as in it proposes that the list may not include a word at all, or a specific word, and should be rephrased for clarity.

In claim 1, lines 24 and 25, "assigning said frequency count to every selected word; storing said frequency count" is confusing, wherein, in lines 11 and 12, there is a step of "assigning a frequency count to said user-defined word; storing said frequency count is said UDB." The Examiner notes this is a specific frequency count or number, not a frequency counter (for example, a frequency count for this clause for the word "for" would be 4, a specific number). Therefore, as currently claimed, "every selected word" will have the same frequency count/number, which renders the claim confusing, if intended to reorder information based on frequency (The Examiner notes, if there is a "frequency of use" or "frequency counter" attached to a selected word, which should probably include a frequency count, which is updated according to each selection of the corresponding word).

In claim 1, line 29-line 36, "accepting a subsequent user input", from this point on, there is no selection of any word from the subsequent input, therefore, there may be no frequency of use assigned to this particular

input, therefore, the Examiner fails to recognize how "if more than one word matches said user's subsequent input, dynamically reordering...according to said frequency count. The Examiner notes there is no original, or predetermined frequency count for words in the LDB, they are simply ordered in the LDB according to a frequency of use model (i.e. cat, category), wherein the frequency of use model may have determined a frequency count for a set of words, and then placed the words in an LDB in a particular order.

In claim 1, line 32, 33, "dynamically reordering any matching words in said LDB as ordered in said LDB" is confusing. As ordered in the LDB, according to the claim, calls for "ordering a plurality of words stored in a linguistic database (LD) according to a predefined linguistics frequency of use model." The Examiner is unsure of what is meant to "reorder" according to the predefined frequency of use model" (which doesn't have any initial frequency attached to the words in the LDB).

In claim 1, lines 32-34, "if more than one word matches said user's subsequent input, dynamically reordering any matching words in said LDB as ordered in said LDB and any matching words in said UDB according to a frequency count" is also confusing, based on the two above paragraphs.

The subsequent word has not been selected, (i.e. bask, and matching words –LDB-basket, and basketcase-UDB) and thus it is possible that there isn't any frequency count attached to the subsequent word. Furthermore, the Examiner is unsure of the phrase "if more than one word matches", as in "basket" and "basketcase" one from the LDB and one from the UDB, or more than one word as in "basket" and "basketball", both in the LDB, or two words in the UDB, or all of the above (applicant does not provide teaching for all permutations of the above subject matter).

In claim 1, lines 35 and 36, the Examiner notes the displayed list, should probably be in a particular order based on frequency, as claimed, the display only includes "reordered matching words if more than one word matches."

Claims 9 and 15 have similar issues.

In claim 16, lines 7 and 8 "said words retrieved from said LDB and from said UDB" is confusing, wherein, the words cannot be retrieved from both, wherein there are particular words that can be retrieved from the LDB and UDB, **respectively**.

In claim 16, line 10, "see claim 1, "frequency count" discussion, if deemed applicable.

In claim 16, line 12, “and an object number corresponding to said frequency count” is confusing, the Examiner is unsure of how an object number is to relate to a frequency count as it would to a word (see claim 1-UDB and object number).

In claim 16, lines 15-17, “said words dynamically reordered according to said frequency count.” has the same issues of claim 1, wherein the words from the LDB, have not been selected at this current point, and do not have a frequency count (see claim 1, corresponding frequency count/LDB discussion).

In claim 16 lines 21-21, “a module for assigning said frequency count to any words selected by said user and inserting said selected words’ frequency counts into said UDB” has the same “frequency count/frequency counter” issue as discussed in claim 1 (as the frequency count pertains to a particular number), and it is further noted that the above limitation only inserts the frequency count into the UDB, thus only a number, without any attachment, is inserted into the UDB (i.e. without an attachment to an object number attached to a word, etc.).

Claims 24 and 30 have the same issues.

Allowable Subject Matter

7. Claims 1, 9, 15, 24 and 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The Examiner notes the prosecution history explicitly details the reasons for allowance. For example, King (US 6,307,549) discloses a reduced keyboard disambiguating system where words are stored in the form of objects associated with an arbitrary keystroke sequence. The objects are ordered in decreasing frequency of use. This frequency of use can be modified according to a user's frequency of use as opposed to a default frequency of use setting. King does not disclose only associating a frequency of use with words selected by a user and user-defined words.

8. The non-obvious improvement regarding claims 9, 15, 16, 24, and 30 indicated in the previous office action (as the dependent forms of the claims now incorporating all of the limitations of their base claims and any intervening claims). Furthermore, regarding amended claims 1, 9, 15, 16, 24, and 30, only words selected by a user or user-defined words are associated with a frequency of use. All other words are ordered according

to a predetermined linguistics frequency of use model that is not also stored in the database. Furthermore, King does not disclose taking a list of words ordered according to a default frequency of use and reordering them according to a frequency of use associated with words selected by a user and with user-defined words. In King there is only one list of words where all words are associated with a frequency of use and ordered accordingly. The Examiner notes, King with Borland (US 6,320,943) and with Miller (US 5,805,911) fail to teach the above non-obvious improvement as indicated.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAMONT M. SPOONER whose telephone number is (571)272-7613. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on 571/272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

lms
12/28/08

/Patrick N. Edouard/
Supervisory Patent Examiner, Art Unit 2626